

Appl. No. : 10/047,460
Filed : January 14, 2002

REMARKS

Following a personal interview of August 27, 2003, Applicants filed a response to the pending Final Office action. In an Advisory Action dated September 25, 2003, the Examiner indicated that the amendments were not entered because they allegedly raised new issues that required further search. The Examiner further indicated that the rejections set forth in the Final Office Action are maintained. Applicants hereby submit amendments and arguments along with a Request for Continued Examination (RCE) in order for the amendments to be considered.

Applicants have amended Claims 1 and 21, the pending independent claims. No claim has been cancelled. Accordingly, Claims 1-3, 21-28, and 32-36 remain pending.

Applicants respond below to the specific rejections and objections raised by the Examiner in the Office Action of July 10, 2003.

The pending claims stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by Deininger '573. The presently pending claims also stand rejected under 35 U.S.C. § 103(a) over the combinations of (i) Johnson '994 in view of Deininger '573, (ii) Mills '090 in view of Deininger '573, and (iii) Harrison '553 in view of Deininger '573. For the reasons set forth below, Applicants respectfully traverse these rejections.

In the Office Actions, the Examiner states that Johnson, Mills, and Harrison each do not teach at least one limitation of the present claims. The Examiner notes that these references "do[] not specifically teach delivering at least a portion of the ferrate to a site of use that is proximal to the mixing or reaction chamber." See Office Action of July 10, 2003 (Paper No. 10), page 2, lines 18-19; page 3, lines 6-8, and lines 16-18. Accordingly, the Examiner has asserted that the teachings of these primary references may be combined with that of Deininger '573, which allegedly provides the missing element. The Office Action also states

Deininger takes the ferrate from the reactor and delivers it to a centrifuge which uses it to separate water therefrom as shown in the Figure. *The centrifuge is a site that is proximal to the reactor.* (Emphasis added).

Applicants respectfully disagree. The site of centrifugation of a ferrate solution is not within the scope of the term "site of use," as defined in the specification, and now as expressly recited in the claims. Therefore, the centrifuge is not properly considered a "site of use." The specification defines the term "site of use" in Paragraph [0047], as follows: "The terms 'site of use,' 'use site,' or 'treatment site' refer to the site where the ferrate is contacted with the object it

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is to oxidize, synthesize, disinfect, clean, plate, encapsulate, or coagulate." Plainly speaking, the centrifuge is not oxidized, synthesized, disinfected, cleaned, plated, encapsulated, or coagulated by ferrate when a ferrate solution is centrifuged; the centrifuge of Deininger '573 is not a site of use, as that term would be ordinarily understood or as it is defined in the specification.

In order to expedite prosecution and advance the case towards allowance, without narrowing the pending claims Applicants have amended Claims 1 and 21, the two pending independent claims, by expressly incorporating the definition of "site of use" into these claims. Applicants note that while these amendments further clarify the claims' recitation of the term "site of use." See, for example, *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996) or *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). The term "site of use" originally had the scope afforded it in the specification at Paragraph [0047]. The explicit recitation of this definition in the claim retains the original scope of the term. Accordingly, the present amendment does not narrow the claimed subject matter. See, for example, *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371 (Fed. Cir. 2001).

In sum, Applicants respectfully maintain that because the cited references, either individually or in combination, do not teach or suggest at least one of the elements of the claimed invention, the claims are neither anticipated by nor are obvious over the cited references. Consequently, Applicants respectfully request that the Examiner reconsider and withdraw all the pending rejections.

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CONCLUSION

Applicants have endeavored to respond to all of the Examiners comments and rejections. Applicants respectfully submit that the claims, as amended herewith, are patentable and should be passed to issue. A notice to that effect is respectfully requested.

No fee is believed due in connection with this response. If this is not correct, please charge any required fees, including any fees for extension of time, to Deposit Account No. 11-1410. The Examiner is invited to call Applicant's representative at the number listed below if any issues can be resolved telephonically.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: Oct. 2, 2003

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